Remarks

Claims 1, 3, 8, 14 – 16, 23, 25, 30, 36 – 38, 67 and 68 have not been amended. No claims have been canceled. Claims 1, 3, 8, 14 – 16, 23, 25, 30, 36 – 38, 67 and 68 remain pending in the application.

Priority Claim

The Examiner has maintained the issue previously raised as to whether the present patent application disclosure and the present claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 can claim priority to the filing dates of the provisional application 60/110,952 (hereafter '952 Application) and the utility application 09/372,253. The Examiner generally cited the requirements of 35 USC 112, first paragraph in support of this issue of priority claiming. More specifically, the Examiner continues to state that the subject matter of currently amended independent claims 1 and 23 is not supported by the priority documents in that permitting download of the file based on a number of attempted downloads of the file by the user and the number of successful downloads of the file by the user is not supported.

The Applicant thanks the Examiner for once again reviewing the contents of the provisional application '952 and utility application '253. The Examiner noted that the provisional application '952 consisted of 30 pages, but no Appendix. Upon review of the image file wrapper at the USPTO and the provisional application copy in the Applicant's owns files, a discrepancy has been discovered. In particular, the Applicant's files contain a 46 page provisional application with 23 pages from Appendix A, B, and C. In addition, the transmittal letter and return postcard (see attached 3 page Exhibit A) indicate that the U.S. Patent Office received a 46 page specification. Therefore, it appears that the USPTO image file wrapper is missing part of the original provisional patent application '952 as filed. The Applicant offers to provide a copy of the material upon request to help reconstruct the USPTO files if the missing 23 pages cannot be located in the USPTO files.

These missing 23 pages from Appendix A, B, and C of the '952 provisional application form the basis for Applicant's argument that the provisional application 60/110,952

provides support for the present claims. In particular, support of the claims involving permitting a limited number of downloads is found in the provisional application '952 Application in several places. See for example, the text in '952 Application, Appendix A, page 3, last paragraph. For the Examiner's convenience, the text of Appendix A, page 3, last paragraph is reproduced below.

> Protection of the software products themselves is the highest priority for Digital River security. Their digital inventory is protected behind secured firewalls so that it cannot be accessed by unauthorized users. Secure electronic software distribution through Digital River can reduce the unauthorized duplication and distribution of copyrighted materials, since there are no diskettes to copy or trade. Digital River maximizes this security by limiting the number of approved downloads, and only allows them to take place within five days of a customer purchase. Digital River's

Also, see for example, the text in '952 Application, Appendix B, page 4, first full paragraph. For the Examiner's convenience, the text of Appendix A B, page 4, first full paragraph is reproduced below.

> The SDM accumulates information and learns about each user as it performs security profiling based on many discrete variables. So the more illegal attempts that are made, the more effectively the security system thwarts them. For example, users have only a few tries to enter their access number correctly before they are instructed to call Customer Service. Similarly, a customer cannot download software more than a preset number of times in a certain period, or buy one copy of a product and then download 500 copies. These built-in protections of the SDM also prevent spammers from shutting down the network with junk email.

In addition, see for example, the text in '952 Application, Appendix C, page 3, third full paragraph. For the Examiner's convenience, the text of Appendix C, page 3, third full paragraph is reproduced below.

> The SDM profiling accumulates information and learns about each user as it performs security profiling based on many discrete variables, so the more illegal attempts that are made, the more effectively the security system thwarts them. For example, users have only a few tries to enter their access number correctly before they are instructed to call Customer Service. Similarly, a customer cannot download software more than a preset number of times in a certain period, or buy one copy of a product and then download 500 copies. These built-in protections of the SDM also prevent spammers from shutting down the network with junk e-mail.

In addition, the non-provisional application 09/372,253, like the present patent application, specifically incorporates by reference all of the text and drawings of the provisional application. As such, the support for claims 1 and 23 found in the '952 Application is also in the parent non-provisional application 09/372,253.

Therefore, the Applicant respectfully requests reconsideration and withdrawn of the objections to the priority claim and the pending claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 under 35 USC 112, first paragraph.

35 U.S.C. §103

Claims 1, 3, 8, 14-16, 23, 25, 30, 36 – 38 and 67 – 68 were rejected under 35 USC §103(a) as being unpatentable over Downs '618 in view of Rogers '786 (US Patent 5,652,786). In the June 29, 2005 Office Action and more specifically to page 7, the Examiner stated that "Downs does not teach permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user." The Applicant agrees with this assessment of Downs '618.

The Examiner cited Rogers '786 with particular reference to column 6, line 33 to column 9, line 17. The Examiner stated that Rogers '786 teaches, in analogous field of endeavor, the bill payment via a network permitting download of the file based on a number of attempted downloads of the file by the user and a number of successful downloads of the file by the user. For several reasons, the Applicant respectfully disagrees with this characterization of Rogers '786 and its use in combination with Downs '618.

First, all the rejections cited under §103(a) cite Rogers '786; however, this reference is not prior art, but rather nonanalogous art, and may not be relied upon as a basis for rejection of the applicant's invention. In order to rely on a reference as a basis for rejection of Applicant's invention, the reference must either be in the field of Applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned. In re Oetiker, 977 F2d 1443, 1446, 24 USPQ 2d 1443, 1445 (Fed. Cir. 1992). MPEP 2141.01(a). Applicant's invention, as claimed, relates to downloading of software over a network such as the Internet. In contrast, Rogers '786 relates to debit card payment systems having a debit card transaction approval process. Clearly, Rogers '786 field of study in debit cards payment systems does not relate to the Applicant's endeavor in software downloading, as claimed. In addition, Rogers '786 is not reasonably pertinent to the problems addressed by the Applicant in fraud protection for software downloading, because debit cards taught by Rogers '786, would not logically have been considered by the Applicant when considering the problems of the Applicant's invention, as claimed.

Second, Rogers '786 is a non-enabling reference. Rogers '786 fails to teach the downloading of anything, even a credit card file. Rogers '786, in column 6, lines 48-60, discloses checking a caller entered access code is valid and asks the caller to call again, if a valid access code is not entered after three successive access code entries. Rogers '786 describes similar checking for account number, debit card number, dollar amount, validity. In addition, Rogers '786 describes restricting the number of electronic payments over a 30 day period through the use of velocity file that tracks uses of the debit card. Nowhere in the Rogers '786 reference does it suggest the actual download of a file to a caller or user and furthermore no apparatus is disclosed that could store and access such a file at a later time. Even if Rogers '786 were used to modify Downs '618, the Examiner's proposed modification would render the cited references being modified unsatisfactory for its intended purpose. Here, if the second reference, Rogers '786, were used in combination with the primary reference, Downs '618, the proposed modification would render the Downs '618 reference unsatisfactory for its intended purpose. Applicant respectfully submits it would not be obvious to one or ordinary skill in the art at the time the invention was made to know how to modify Downs '618 by

limiting downloads of software based on whether a valid access code or other number had been entered correctly within three times by a caller as taught by Rogers '786. In fact, Rogers '786 does not teach limiting downloads based on number of times that they were downloaded in the past at all, but only permits a debit card transaction when valid numbers are entered and a number of electronic debit card transactions has been exceeded in a 30 day period. The proposed combination of Downs '618, when combined with Rogers '786, still fails to accomplish the intended purpose of the claimed invention, namely to permitting download of a file based on a number of attempted downloads of that file by the user.

Third, Downs '618 and Rogers '786 to not suggest that either reference should be combined with the other and the Examiner fails to offer any reason to combine the references or at least the reasoning offered in the office action presents an insufficient suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the cited reference teachings. The Applicant wishes to remind the Examiner that any assertion of obviousness may not be based on improper hindsight reasoning. The judgment of obviousness over these references appears to take into account more knowledge than what was within the level of ordinary skill in the art at the time the claimed invention was made, and appears to include additional knowledge gleaned only from the Applicant's disclosure.

In summary, the Applicant respectfully suggests that the Examiner has failed to establish a prima facie case of obviousness. There is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference, or to combine the reference teachings. In addition, the cited references, when combined, fail to teach or suggest all the claim limitations. The necessary teaching or suggestion to make the claim combination and the reasonable expectation of success is not both found in the cited references. Applicant respectfully suggests that Downs '618 and Rogers '786 when considered individually or together in combination, fail to suggest or teach all of the elements of the presently pending claims. For example, neither Downs '618 nor Rogers '786 teach, as

presently claimed in independent claims 1 and 23, permitting download of the file based on a number of attempted downloads of the file by the user. Also, neither Downs '618 nor Rogers '786 teach permitting download of the file based on a number of successful downloads of the file by the user.

Claims 3, 8, 14-16, and 67 depend from claim 1 and therefore are allowable over Downs '618 and Rogers '786 for the same reasons that claim 1 is allowable. Claims 25, 30, 36-38, and 68 depend from claim 23 and therefore are allowable over Downs '618 and Rogers '786 for the same reasons that claim 23 is allowable.

Therefore, under 35 USC §103(a) Downs '618 and Rogers '786 fail to teach the present invention as claimed in claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67 and 68 and a withdrawal of this objection is respectfully requested.

The Applicant has reviewed the other references cited the by Examiner and determined that they do not teach or suggest the present invention.

Conclusion

On the basis of the foregoing, Applicant respectfully submits that claims 1, 3, 8, 14-16, 23, 25, 30, 36-38, 67, and 68 are now believed to be in condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

DIGITAL RIVER, INC.
By agents:

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45 Island Road
North Oaks, Minnesota 55127
(612) 850-1688

Date: 29 December 2005 By _____
Shawn B. Dempster , Registration No. 34,321

C:\NOPA\CLIENTS\DIGITAL RIVER D33\D33-029-03-US APPARATUS AND METHOD FOR SECURE DOWNLOADING OF FILES\051229 RESPONSE TO OA.DOC

Exhibit A

PTO/SB/16 (6-95
Approved for use through 04/11/98. OMB 0651-0037
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

PROVISIONAL APPLICATION COVER SHEET

This is a request for filing a PROVISIONAL APPLICATION under 37 CFR 1.53 (b)(2). EL115562668US

		Docket No.	6420	Type a plus sign (+) inside this box →	+
INVENTOR(S)					
Last Name	First Name	Middle Initial	Residence (City and either state or foreign country)		
Ronning	Joel		Excelsior, Minnesota, citizen of United States		
TITLE OF THE INVENTION					
APPARATUS AND METHOD FOR PROVIDING ELECTRONIC COMMERCE					
CORRESPONDENCE ADDRESS					
Lance Vietzke, Dorsey & Whitney LLP, Pillsbury Center South, 220 South Sixth Street					
State	Minnesota	ZIP Code	55402-1498	Country	USA
ENCLOSED APPLICATION PARTS *(check all that apply)*					
☒ Specification	*number of pages* 46		☐ Small Entity Statement		
☒ Drawing(s)	*number of sheets* 4		☐ Other (specify) Check no. _____ for $XXX.XX		
METHOD OF PAYMENT					
☒ A check or money order is enclosed to cover the Provisional filing fees				PROVISIONAL FILING FEE AMOUNT($)	$150.00
☒ The Commissioner is hereby authorized to charge filing fees and credit Deposit Account Number: 04-1420					

The invention was made by an agency of the United States Government or under a contract with an agency of the United States Government.

☒ No.

☐ Yes, the name of the U.S. Government Agency and the Government contract number are:

Respectfully submitted,

Signature: Lance Vietzke Date: 12/4/98

Typed or Printed Name: Lance Vietzke

Registration No. 36,708
(if appropriate)

☒ Additional inventors are being named on separately numbered sheets attached hereto.

PROVISIONAL APPLICATION FILING ONLY

Burden Hour Statement: This form is estimated to take .2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Office of Assistance Quality Enhancement Division. Patent and Trademark Office, Washington, D.C. 20231, and to the Office of Information and Regulatory Affairs, Office of Management and Budget (Project 0651-0037), Washington, D.C. 20503. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, D.C. 20231

Exhibit A

Additional Inventors

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Date of Deposit 12/4/98

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Elvina Smith

Name

Elvina Smith

Signature

Exhibit A

The mail stamp of the Patent and Trademark Office on this card acknowledges the filing of the items listed below on the date indicated:

Provisional Patent Application Transmittal Letter; Provisional Patent Application - 46 pages; 4 sheets of informal drawings; and, a check in the amount of $150

Return Receipt Post Card

Title:	APPARATUS AND METHOD FOR PROVIDING ELECTRONIC COMMERCE
Applicant:	Digital River, Inc.
Inventor:	Ronning et al.
Serial No.:	N/A
Dkt No.:	6420
Initials:	LV/bjs
Mailed:	12/4/98
Express Mail No.:	EL115562668US

jc541 U.S. PTO
60/110952
12/04/98

Awaiting Official Filing Receipt 3-4-99
Filing Non-provisional - 12-3-99
[illegible] - 12-4-99